

Appln. No. 09/944,009
Amendment dated May 9, 2005
Reply to Office Action mailed January 7, 2005

REMARKS

Reconsideration is respectfully requested.

Claims 1, 3, 4, 7, 8, 11, 13 through 16, 21 through 24, and 26 remain in this application. No claims have been cancelled or withdrawn. Claim 27 have been added.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

Paragraph 3 of the Office Action

The specification has been objected to for the informalities noted in the Office Action.

The Abstract has been amended in a manner believed to clarify any informalities in the language, particularly at the points identified in the Office Action.

Withdrawal of the objection is respectfully requested.

Paragraphs 4 and 5 of the Office Action

Claims 1, 4, 7, 14, 21-23 and 26 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Butler et al. (USPN 3,301,101) in view of Ishizawa et al. (USPN 5,495,973).

Claim 1 requires, in part, "wherein the channel of the guide bushing has an entire length extending from a first end of the guide bushing to a second, opposite end of the guide bushing, the channel having a uniform diameter along said entire length of the guide bushing".

In contrast, the Butler patent relied upon in the Office Action shows a fastener guide (10) that includes a an internal surface that has a varying

Appln. No. 09/944,009
Amendment dated May 9, 2005
Reply to Office Action mailed January 7, 2005

diameter, as is clearly set forth in the Butler patent at col. 3, lines 52 through 56 (emphasis added):

The internal surface of the fastener guide 10 includes a counterbore 112 adjacent to the muzzle end thereof, a reduced cylindrical portion 114, and an inwardly tapering portion 116 adjacent the rearward end.

Therefore, in light of this express description of the differing diameters of the internal surface of the fastener guide (10), which is also clearly shown in Figure 1 of the drawings of Butler, it is submitted that the Butler structure could not lead one of ordinary skill in the art to the claimed guide bushing "having a substantially uniform diameter along said entire length of the guide bushing".

It is contended in the Office Action that the Butler patent teaches an "entire length [] substantially uniform in diameter along the entire length, and the uniform diameter being slightly larger than the forward end of the drive punch". However, this interpretation of the "uniform" requirement of claim 1 renders the term almost meaningless, as the Butler patent not only explicitly states that the diameters are different at the different portions, Figure 1 of the drawings of Butler clearly show a significant size difference between the diameter at 112 and at 114. Even though the drawings of a patent are not drawn to a particular scale, one of ordinary skill in the art can appreciate from the showing in Figure 1 of the Butler patent that the counterbore (112) is approximately 40% larger than the "reduce cylindrical portion 114". It is thus submitted that one of ordinary skill in the art would not appreciate this significant difference as "slight".

Further, claim 1 requires "wherein the uniform diameter of the channel of the guide bushing along said entire length is slightly larger than a diameter of the forward end of the drive punch". Clearly, as shown above, the internal surface of the fastener guide is not uniform, and looking to the disclosure of the relative sizes of the internal surfaces of the guide (10) and the piston member (6) as shown in Figure 1 of the Butler patent, the

Appln. No. 09/944,009
Amendment dated May 9, 2005
Reply to Office Action mailed January 7, 2005

counterbore (112) portion of the internal surface is clearly much larger in diameter than the diameter of the piston member of the Butler device. It is therefore submitted that the Butler patent could not lead one of ordinary skill in the art to the requirement of "the uniform diameter of the channel of the guide bushing along said entire length is slightly larger than a diameter of the forward end of the drive punch".

It is therefore submitted that the cited patents, and especially the allegedly obvious combination of Butler and Ishizawa set forth in the rejection of the Office Action, would not lead one skilled in the art to the applicant's invention as required by claim 1. Further, the claims that depend from claim 1 also include the requirements discussed above and therefore are also submitted to be in condition for allowance.

Withdrawal of the §103(a) rejection of claims 1, 4, 7, 14, 21 through 23 and 26 is therefore respectfully requested.

Paragraph 7 of the Office Action


Claims 8, 11, 13, 15, 16 and 24 have been allowed.

CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

LEONARD & PROEHL, Prof. L.L.C.

By 
Jeffrey A. Proehl (Reg. No. 35,987)
LEONARD & PROEHL, Prof. L.L.C.
3500 South First Avenue Circle, Suite 250
Sioux Falls, SD 57105-5807
(605)339-2028 FAX (605)336-1931

Date: 